

The present application is a continuation of the US national stage designation of International application PCT/EP99/06091 filed August 17, 1999, only a few months after the issuance of the cited US patent to Engle. Furthermore, both the Engle patent and the present application are owned by the same entity, Nestec SA, so that a rejection under 35 USC §102(e)/103(a) is inappropriate. Accordingly, the rejection based on Engle cannot be sustained and should be withdrawn.

The present claims were also rejected under the judicially created doctrine of obviousness-type double patenting over the claims of the Engle patent. Specifically, the Examiner alleges that the claims of the Engle and those of the present invention are not patentably distinct because the use of a fresh whole milk in the present invention instead of a reconstituted milk as in Engle is "merely a matter of choice and well within the skill of the art" Applicants respectfully traverse this rejection.

The present invention relates to a process for the manufacture of an evaporated milk product from a whey product, in which the whey is optionally partially substituted with lactose. Claim 1 reads as follows:

A process for the preparation of an evaporated milk product whose organoleptic qualities are similar to those of fresh milk, which comprises:
mixing a whey product with fresh whole milk to form a lactic solution;
pasteurizing and concentrating the lactic solution to form a concentrate;
thermally treating and homogenizing the concentrate; and
cooling, packaging and sterilizing the concentrate as the evaporated milk product.

This claim is quite different from claim 1 of the Engle patent, which reads as follows:

A process for preparing a milk substitute composition comprising:
dissolving a whey solids powder in an aqueous medium comprising calcium sequestering agent and carrageenane components at a temperature of approximately from 30°C to 65°C to obtain a whey-containing medium having an aqueous liquid phase;

dissolving a skimmed milk solids powder in the whey-containing medium at a temperature of approximately from 30°C to 65°C to obtain a milk substitute composition having an aqueous liquid phase; and

allowing, before and/or after dissolving the skimmed milk solids powder, the whey solids to soak in the aqueous liquid phase for from 10 minutes to 4 hours for hydrating the whey solids.

These two claims are quite different. Contrary to the Examiner's assertion that the only difference between the present invention and Engel is the source of milk product, it is noted that the present invention also differs from Engel in that the present process includes an additional, important step which concentrates the mixture of a whey product and a fresh milk product, preferably by evaporation (*See*, Specification, page 2, third full paragraph; also, claim 1 above). Nowhere does Engel mention the possibility or the requirement of an concentration or evaporation step to concentrate the lactose solution, nor would one be suggested since Engle's product is different from that of the present invention.

Furthermore, the present invention explicitly states the drawbacks of Engel (page 1, last full paragraph, note that EP 0,627,169 is a member of the family of the applications corresponding to the Engel US patent cited by the Examiner). The specification explains that the process of Engel is based on a sequential dissolution of the whey proteins, and then of milk with no evaporation of the whey proteins as it is a recombination. As a result, it is not possible with the process taught by Engel to preserve the organoleptic qualities of that product to be close to those which characterize fresh milk (Specification, page 1, last full paragraph) and which are characteristic of the products of the present invention.

The present invention overcomes the deficiencies of Engel by using whole milk as the milk source as well as including an additional step of concentrating the lactic solution by evaporation. Specifically, the present invention avoids the cooked flavor generally associated with concentration by evaporation by starting with fresh milk. This unexpected improvement in the organoleptic properties of the evaporated milk product supports the patentability of claim 1 over Engle. The dependent claims of the present application define additional features of the invention that further distinguish the invention from the Engle patent. Accordingly, as Engel does not teach the use of whole milk as a milk source, nor does it teach the use of a concentration or evaporation step, the Examiner's rejection of the claims based on obviousness-type double patenting over Engle should be withdrawn.

In view of the above, all rejections have been overcome and should be withdrawn. Accordingly, the entire application is believed to be in condition for allowance, early notice of which would be appreciated. Should the Examiner not agree, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the claims.

No fee is believed to be due for this submission except for a petition to extend the period for response, which petition is being filed concurrently herewith. Should any additional fees be due, however, please charge such fees to Winston & Strawn Deposit Account No. 501-814.

Respectfully submitted,

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